



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/276,868 | 03/26/1999 | MICHAEL SIMONS | BIS-043 | 2716 |

7590 11/14/2002

DAVID PRASHKER PC
PO BOX 5387
MAGNOLIA, MA 01930

EXAMINER

KAM, CHIH MIN

ART UNIT PAPER NUMBER

1653

DATE MAILED: 11/14/2002

LL

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|---------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/276,868 | SIMONS ET AL. | |
| Examiner | Art Unit | | |
| Chih-Min Kam | 1653 | | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 29 August 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 11-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 11-15 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) Interview Summary (PTO-413) Paper No(s). _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Status of the Claims

1. Claims 11-15 are pending.

Applicants' amendment filed on August 29, 2002 (Paper No. 20) is acknowledged, and applicant's response has been fully considered. Claims 11-15 have been amended, and claims 1-10 have been cancelled. Therefore, claims 11-15 are under examination.

2. Applicants' submission of Fig. 9 and Fig. 10 is acknowledged.

Objection Withdrawn

3. The previous objection to the disclosure regarding “[SEQ ID NO:]” is withdrawn in view of applicants' amendment to the specification, and applicants' response at page 9 in Paper No. 20.

4. The previous objection to claims 11-14 regarding the term “being” missing in claim 11 and “[SEQ ID NO:]” is withdrawn in view of applicants' amendment to the claim, and applicants' response at page 9 in Paper No. 20.

Rejection Withdrawn

Claim Rejections-Obviousness Type Double Patenting

5. The previous rejection of claims 11-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-14 of copending Application No. 09/426,011, is withdrawn in view of applicants' submission of terminal disclaimer, and applicants' response at pages 29-30 in Paper No. 20.

Claim Rejections – 35 USC § 112

6. The previous rejection of claims 11-15 under 35 USC § 112, first paragraph, is withdrawn in view of applicants' response at pages 10-26 in Paper No. 20.
7. The previous rejection of claims 11-15 under 35 USC § 112, second paragraph regarding the term "PR-39", "PR-39 derived oligopeptides", "at least one identifiable peptide", "at least partially homologous with ...PR-39 peptide", "markedly altering", "to interact in-situ with at least the α 7 subunit of such proteasomes", "markedly inhibited" and "other individual peptides", is withdrawn in view of applicants' amendment to the claims and applicants' response at pages 26-29 in Paper No. 20.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11-15 are indefinite because of the use of the terms "at least one specific peptide", and "other peptides". The terms cited above render the claim indefinite, it is unclear what peptide is intended as to "at least one specific peptide", and what peptides are intended as to "other peptides". Claims 12-14 are included in this rejection for being dependent on a rejected claim and not correcting the deficiency of the claim from which they depend.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Blecha *et al.* (WO 96-32129).

Blecha *et al.* teach PR-39 and truncated analogs such as PR-14 and PR-19 inhibit leukocyte superoxide anion production and attract leukocytes, thus, these peptides can be used as medicaments that fight infection by attracting leukocytes to a wound site to restrict tissue damage (page 3). The truncated analog PR-14 (RRRPRPPYLPRLPRP, Fig. 1) comprises the amino acid sequence of SEQ ID NO:4 (RRRPRPPYLPRL, claim 13) or SEQ ID NO: 5 (RRRPRPPY, claim 14), and PR-19 (RRRPRPPYLPRLPRPRPPPFFP, Fig. 1) comprises the amino acid sequence of SEQ ID NO:3 (RRRPRPPYLPRLPRP, claim 12). These truncated analogs of PR-39 have the inherent characteristics and properties of the claimed peptides cited in the claim (claims 11 and 15) since they contain the claimed amino acid sequence of SEQ ID NO: 3, 4 or 5.

Conclusion

10. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

Art Unit: 1653

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. *CK*
Patent Examiner

Karen Cochrane Carlson Ph.D
KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER

November 9, 2002